



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,545	03/18/2002	Takumi Takahashi	03500.016292	4950

5514 7590 11/03/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

DURNFORD GESZVAIN, DILLON

ART UNIT PAPER NUMBER

2622

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/098,545	Applicant(s) TAKAHASHI, TAKUMI	
	Examiner Dillon Durnford-Geszvain	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Final Office Action mailed 9/21/2006 is vacated by the present Final Office Action.

Response to Amendment

2. Claims **1, 2, 4-12** and **14-39** are pending, claims **1, 2, 4-6, 8, 10, 12, 14-16, 18-22, 24, 30, 32, 34** and **36-38** are amended and claims **3** and **13** are cancelled.

Response to Arguments

3. Applicant's arguments filed 6/19/06 have been fully considered but they are not persuasive. The Applicant argues that the combination of the two references would not have produced a useful effect. However, the Examiner believes that the Applicant has mischaracterized the intent of the combination of the references. The Examiner did not suggest that the outputting of a monitor report be incorporated into the device of Tanaka (US) but instead suggested using "a determination step as taught by Tanaka (JP) in the image transfer method of Tanaka (US)" (see page 5 of the Office Action mailed 3/13/2006). The Applicant appears to argue that this constitutes printing out a report when the Examiner clearly intended for only the listing of images and the determination step associated with the invention of Tanaka (JP) to be combined with the invention of Tanaka (US).

The Applicant goes on to argue, on page 16, that Tanaka (US) already teaches using a list to select an image to be transferred. However, Tanaka (US) teaches that a list with accompanying thumbnail images is displayed to choose an image for transfer

Art Unit: 2622

(see at least [0091] and figs. 5 and 12). Therefore, in the invention suggested by the combination, if there were a large number of images (i.e. greater than a threshold) then the thumbnail data would not be transferred and therefore the user could select a desired image for transfer from a list without having to wait for thumbnails to be transferred.

Claim Rejections - 35 USC § 112

4. Claims 1, 2, 4-12 and 14-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the specification as originally filed for a "determination step of determining a display capability of the image display device" as is claimed in all of the independent claims as amended. The specification instead states that the display capability of the image display device is a given parameter and the number of images stored on the image storage device are checked against this parameter (see page 14 lines 2-5 of the present application for example). Therefore there is no determination step of determining the display capability of the display device as it is a given (or predetermined) parameter (e.g. four) that does not need to be determined.

Therefore, the rejections on the merits will be maintained, as the amendment to

the claims was improper.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims **1, 4-10, 12, 14** and **16-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0041056 (Tanaka et al. hereinafter Tanaka (US)) in view of Japanese Published Patent Application H06-233044 (Tanaka et al. hereinafter Tanaka JP).

As to claim **1**, Tanaka (US) teaches a method for displaying on an image display device 80 an image stored in an image storage device 10 (Fig. 3) comprising: receiving and displaying file list information on the image receiving device 80 (see [0088], Fig. 6). Further comprising receiving and displaying thumbnail information corresponding to the file list information previously received (lines 4-8 of [0091]).

Note that Tanaka (US) teaches listing both the file name 128 and thumbnail information 86 corresponding to that file name as shown in Fig. 5.

Tanaka (US) does not teach a determination step for determining if an image is to be displayed or characters (i.e. a name) is to be displayed, in accordance with the number of images stored in the image storage device.

However, Tanaka (JP) teaches a method for receiving images with an image reception device (a fax machine) that employs a determination step as to whether to

Art Unit: 2622

output the images or a report about the images depending on whether the number of received images is greater than a threshold value ([0028]). Note that Tanaka (JP) further teaches that "the monitor report writing section 19 ... compounds a part or all of the drawing information memory 2 to drawing information according to a format of a schedule ... these image data, and character data, and outputs to the printing section 11." ([0064]) Tanaka (JP) also teaches that the monitor report has "a publication number (which) may be information which people can recognize and may be information which machines (can read, such as a barcode)." The Examiner asserts that the publication number is comparable to an image name.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a determination step as taught by Tanaka (JP) in the image transfer method of Tanaka (US) as this would allow a user to find a desired picture more quickly if there are a large number of images by searching through only the names of the images which can be loaded much more quickly than thumbnails can be.

As to claim 4, Tanaka (US) and Tanaka (JP) have been described above. As discussed above Tanaka (US) teaches displaying an image and displaying the name of an image. What it doesn't teach is determining if only the name or only the image is to be displayed. However, Tanaka (JP) teaches an image receiving device that outputs image data that uses a method employing a determination step to determine if the image data should be output or names of the images as discussed above in the rejection of claim 1.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the determination step of Tanaka (JP) in the image display method of Tanaka (US) to determine if image data should be output or a name associated with that image should be output as if there are a large number of images in the image storage device 10 it would take a much longer time to display all of the images than to display only the names of the images and this would provide a faster way to search through a large number of images stored in an image storage device.

As to claim 5, see the rejection of claim 4 and note that Tanaka (US) further teaches a name display step of displaying names of multiple images (128 of Fig. 5): and an image display step of displaying one of the multiple images whose names are displayed (86 of Fig. 5).

As to claim 6, this claim is analogous to claim 1 except the applicant specifies that the image storage device determines if image data is to be transmitted or identification of the image data is to be transmitted (instead of displayed) in accordance with the number of images stored in the storage device. What Tanaka (US) and Tanaka (JP) teach has been discussed above. Tanaka (US) describes a "pull" model of receiving image data wherein the image receiver 80 requests information from the image storage device 10 ([0133]). However, Tanaka (US) would have considered a "push" model wherein the image storage device 10 initiates the transfer of images and in this case it would be the image storage device that performs the determination step

Art Unit: 2622

taught by Tanaka (JP).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have use the determination step as taught by Tanaka (JP) in a “push” model of the image transfer system taught by Tanaka (US) as this would allow for faster transfer of data when the amount of images stored on the image storage device is large as images contain much more data than characters and this would facilitate a faster transfer of the desired images.

As to claim 7, see the rejection of claim 6 and note that Tanaka (US) further teaches a wireless transmission step of the image storage device transmitting, using wireless communication, the image data or characters related to the image data to the image reception device (see Fig. 7 and Fig. 2 and [0037]).

As to claim 8, this claim is analogous to claim 6 except the applicant specifies “identification of the image data” as “an image name.” The Examiner states that the grounds for rejection applicable to claim 6 are also applicable to claim 8 since the identification of the image data that Tanaka (US) uses is an image name (see Fig. 5 and [0059] line 14 or line 4 from the bottom).

As to claim 9, see the rejection of claim 8 and note that Tanaka (US) further teaches a display step of displaying multiple names (see Fig. 5) that are transferred; and a transmission step of transmitting from the image storage device to the image

Art Unit: 2622

reception device image data in accordance with one of the displayed multiple names (see [0088] and [0089]).

As to claim **10**, this claim is analogous to claim **1** except it is drawn to a device that carries out the method of claim **1**. Therefore, the same grounds for rejection can be made for claim **10** as for claim **1** except drawn to the device taught by Tanaka (US) in view of Tanaka (JP). Note that Tanaka (US) teaches a display means 88.

As to claim **12**, this claim is analogous to claim **4** except it is drawn to device that carries out the method of claim **4**. Therefore, the same grounds for rejection can be made for claim **12** as for claim **4** except drawn to the device taught by Tanaka (US) in view of Tanaka (JP). Note that Tanaka (US) teaches a display means 88.

As to claim **14**, this claim is analogous to claim **10** except it is drawn to a program for the device of claim **10**. Since there must be a program for making the device of claim **10** perform the method of claim **1** the same argument and grounds for rejection can be made for claim **14** as for claims **1** and **10** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP).

As to claim **16**, this claim is analogous to claim **12** except it is drawn to a program for the device of claim **12**. Since there must be a program for making the device of claim **12** perform the method of claim **4** the same argument and grounds for rejection can be

Art Unit: 2622

made for claim **16** as for claims **4** and **12** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP).

As to claim **17**, this claim is analogous to claim **5** except drawn to a program instead of a method. Therefore the same grounds for rejection can be made for claim **17** as for claim **5** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a method.

As to claim **18**, this claim is similar to claim **12**, except it claims an image storage device instead of an image display device. As Tanaka (US) teaches both an image storage device 10 and an image reception device 80, the same argument can be made for the rejection of claim **18** as that made for the rejection of claim **12**. Note that Tanaka (US) teaches a communication means for communicating between the image storage device and the image reception device ([0037]).

As to claim **19**, this claim is similar to claim **18** except the applicant specifies "an image name" instead of "identification of the image data." Since the image identification data taught by Tanaka (US) is an image name ([0059] line 14) claim **19** can be rejected with the same arguments as those made for claim **18**.

As to claim **20**, this claim is analogous to claim **19** except that is drawn to a program instead of an apparatus. However, since the apparatus must have a program

Art Unit: 2622

for carrying out the functions ascribed to it, the same argument can be used to reject claim **20** as was used to reject claim **19** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a device.

As to claim **21**, this claim is analogous to claim **18** except drawn to a program instead for the apparatus of claim **18**. Therefore, the same argument can be made for the rejection of claim **21** as was made for the rejection of claim **18** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a device.

As to claim **22**, see the rejection of claim **1** and note that if one were to combine the determination step of Tanaka (JP) with the image transfer method of Tanaka (US) that there would necessarily have to be a step where the number of images in the image file list would be determined. If this were not done than no comparison to a threshold would be possible as the number of images that are being transferred would be unknown. Therefore this step is taught implicitly by Tanaka (US) in view of Tanaka (JP).

As to claim **23**, see the rejection of claim **1**, and note that Tanaka (US) further teaches requesting the image that is to be displayed ([0088] and [0089]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have associated the step of requesting an image with the determination step as the step of requesting the image is only done if the determination step determines it is to be

Art Unit: 2622

done and only then would the requesting step be carried out. It wouldn't make any sense to request the image without determining that the image is to be requested.

As to claim **24**, see the rejection of claim **4** and as noted in the rejection of claim **22**, the number of images in the list received by the image display device must be determined in order to compare that number to the threshold taught by Tanaka (JP).

As to claim **25**, see the rejection of claim **4** and note that, as discussed in the rejection of claim **23**, Tanaka (US) teaches a requesting step that one of ordinary skill in the art would associate with the determination step.

As to claim **26**, see the rejection of claim **10** and note that as discussed in the rejection of claim **22** the step of determining the number of image files that are in the image file list sent by the image storage device is a necessary step in the determination step taught by Tanaka (JP).

As to claim **27**, see the rejection of claim **10** and note that claim **27** is a device performing the method of claim **23** and is rejected using the same grounds for rejection of claim **23** as applied to the device of claim **10** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **28**, see the rejection of claim **12** and note that as discussed in the

Art Unit: 2622

rejections of claim **22** the step of determining the number of image files is a necessary step that is implicitly taught by the Tanaka (US) in view of Tanaka (JP).

As to claim **29**, see the rejection of claim **12** and note that claim **29** is similar to claim **27** except the claim which it is dependent upon uses the name of an image to identify images instead of characters related to an image. However, as Tanaka (US) teaches using characters to specify image names this claim can be rejected under the same grounds as claim **27**.

As to claim **30**, see the rejection of claim **14** and note that claim **30** is a program that performs steps corresponding to the steps of claim **22** and is rejected using the same arguments as those used to reject claim **22** except drawn to the program of claim **14** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **31**, see the rejection of claim **14** and note that claim **31** is a program that performs steps corresponding to the steps of claim **23** and is rejected using the same arguments as those used to reject claim **23** except drawn to the program of claim **14** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **32**, see the rejection of claim **16** and note that claim **32** is a program that performs steps corresponding to the steps of claim **24** and is rejected using the same arguments as those used to reject claim **24** except drawn to the program of claim

Art Unit: 2622

16 as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **33**, see the rejection of claim **16** and note that claim **33** is a program that performs steps corresponding to the steps of claim **25** and is rejected using the same arguments as those used to reject claim **25** except drawn to the program of claim **16** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **34**, Tanaka (US) teaches a method for transmitting image data from an image storage device from an image reception device, comprising: a reception step of receiving a request from the image reception device ([0089]).

What Tanaka (US) does not teach is a transmission step of transmitting data of a kind corresponding to the number of images to the image reception device. The Examiner interprets this limitation as meaning that the image storage device either transmits image data or names of images depending on how many images are stored in the storage device.

Tanaka (JP), as discussed above, teaches a determination step to determine if image data should be outputted or characters related to the images should be outputted depending on whether the number of images is above a threshold or not. As discussed in the rejection of claim **6**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed the determination step taught by Tanaka (JP) in the image storage device taught by Tanaka (US) before transmitting data as this would allow for more efficient transfer of data since images contain much

Art Unit: 2622

more information than names. Note that the type of data transferred would then depend on whether the number of images exceeds a threshold value.

As to claim **35**, see the rejection of claim **34** and note that as discussed in the rejection of claim **6** it would have been obvious to one of ordinary skill in the art to transmit either image data or image identifying data in accordance with the number of pictures as this allows for more efficient data transfer since images contain much more information than identification data of images.

As to claim **36**, this claim is a device claim corresponding to the method of claim **34**, and as such is rejected under the same grounds as claim **34** as applied to a device taught by Tanaka (US) in view of Tanaka (JP) instead of a method.

As to claim **37**, see the rejection of claim **36** and note that claim **37** is a device claim corresponding to the method of claim **35** and is rejected on the same grounds as claim **35** as applied to a device taught by Tanaka (US) in view of Tanaka (JP) instead of a method.

As to claim **38**, this claim is a program claim corresponding to the method of claim **34** and is rejected on the same grounds as claim **34** as applied to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a method. This program must exist in order for the processor of Tanaka (US) to perform the method of claim **34**.

As to claim **39**, see the rejection of claim **38** and note that claim **39** is a program claim that corresponds to the method of claim **35** and is rejected on the same grounds as claim **35** as applied to a program taught by Tanaka (US) in view of Tanaka (JP).

7. Claims **2**, **11** and **15** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0041056 (Tanaka (US)) in view of Japanese Published Patent Application H06-233044 (Tanaka JP) as applied to claim **1** further in view of US 6,313,877 (Anderson).

Tanaka (US) teaches a method wherein a thumbnail image display step of displaying a thumbnail image (Fig. 5 and [0090]) and a full image display step of displaying an image corresponding to the displayed thumbnail image ([0112] lines 9-12). What Tanaka (US) does not teach is displaying a plurality of thumbnail images and displaying a full sized image corresponding to one of the displayed thumbnail images.

However, Anderson teaches displaying a plurality of thumbnail images and displaying a full image corresponding to one of the displayed thumbnail images (see Fig. 5 and Column 4 lines 54-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the display style of Anderson in the image transfer system taught by Tanaka (US) in view of Tanaka (JP) as this would allow a user to see many small images and one larger image and would assist the user in readily confirming which image they want to choose when they are choosing from the plurality.

Art Unit: 2622

of thumbnails.

Claim **11** is a device claim that corresponds to the method of claim **2** and is rejected on the same grounds as claim **2** except drawn to a device instead of a method.

Claim **15** is a program claim corresponding to the method of claim **2** and the device of claim **11** and is rejected on the same grounds as those two claims as drawn to a program instead of a device or method. Note that this program is necessary for the device of claim **11** to carry out the method of claim **2**.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2622

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon Durnford-Geszvain whose telephone number is (571) 272-2829. The examiner can normally be reached on Monday through Friday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc-Yen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dillon Durnford-Geszvain

10/26/2006



NGOC-YEN VU
SUPERVISORY PATENT EXAMINER